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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,374	10/26/2000	Wen H. Wu	28939/36715	3688
7590	07/29/2004		EXAMINER	
James J. Napoli Marshall, O'Toole, Gerstein 6300 Sears Tower 233 south Wacker Drive Chicago, IL 60606-6402			COLE, MONIQUE T	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 07/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/697,374	WU	
	Examiner	Art Unit	
	Monique T. Cole	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 May 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4 and 7-17 is/are rejected.
- 7) Claim(s) 6 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 7-12 and the attachment, filed 5/10/2004, with respect to the rejection(s) of claim(s) 1, 4, and 6-17 under 35 USC 102(b) as being anticipated by Gerhart and Robinson have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, new ground(s) of rejection are being made in view of the newly applied references herein.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4 and 7-17 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,370,865 to Yamagishi et al. (herein referred to as "Yamagishi").

4. Yamagishi teaches a composition comprising basic amino acids arginine or lysine in amounts of at least 1% of the composition; water-soluble polymers methyl cellulose, hydroxyethylcellulose in amounts greater than .8% of the composition; and a carrier comprising water. See col. 3, lines 7-13; col. 4, lines 10-12; Examples 7, 8 and 9. The composition may additionally comprise polymers such as polyvinyl alcohol or polyoxyethylene-polyoxypropylene block copolymers (col. 4, line 34). The composition may further comprise an anionic surfactant such as polyethylene glycol.

It is noted that the instant claims recite that the composition be “capable of exhibiting a detectable and measurable color transition in response to a concentration of dialdehyde” however, the claimed composition is limited to components a, b and c and does not require the presence of the dialdehyde. Therefore, as previously pointed out by Applicant in the response filed 4/17/2003, the color response is made *in situ* when combined with the dialdehyde. Since there is no dialdehyde present in the instant composition, there is no color present. Moreover, it is the Examiner’s position that the since the compounds of Yamagishi are the same as those instantly claimed, the composition as claimed by Yamagishi would inherently possess the ability to react colorimetrically to the presence of dialdehyde.

With regard to and in anticipation of Applicant’s argument that the Yamagishi reference is not directed to the same intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If Applicant intent is to patentably protect and focus on the intended use of the composition, perhaps method claims are more suitable.

Allowable Subject Matter

5. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest a composition such as instantly claimed wherein the diamino carboxylic acid is present an amount of about 5-15%.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP 4,937,234 teaches relevant compositions such as those in Examples 8, 10 and 12.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique T. Cole whose telephone number is 571-272-1255. The examiner can normally be reached on Monday-Thursday from 6:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. J. Cole
Monique T. Cole
Examiner
Art Unit 1743

MC